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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,622	12/21/2000	Curtis Cole	JBP-534	7817

7590

04/23/2003

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/23/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,622

Applicant(s)

COLE ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

### **DETAILED ACTION**

Receipt is acknowledged of response filed on January 30, 2003. Claims 1-23 are pending. Rejection under 35 U.S.C. § 102 as indicated in the previous Office action dated September 30, 2002 is withdrawn in view of further consideration. Rejections under § 103 are maintained for the reasons of record as indicated in the previous Office action dated September 30, 2002.

#### **Claim Rejections - 35 USC § 103**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-6, 9, 11, 13-17, 20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu et al. (US 4197316). ("Yu").

Rejection is maintained for the reasons of record as indicated in the previous Office action dated September 30, 2002.

2. Claims 7, 8, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu as applied to claim 1-6, 9, 11, 13-17, 20, 22, and 23 above, and further in view of Znaiden (US 5523090).

Rejection is maintained for the reasons of record as indicated in the previous Office action dated September 30, 2002.

3. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu and Znaiden as applied to claim 1-9, 11, 13-20, 22, and 23 above, and further in view of Perricone (US 5554647).

Rejection is maintained for the reasons of record as indicated in the previous Office action dated September 30, 2002.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu as applied to claims 1-6, 9, 11, 13-17, 20, 22, and 23 above, and further in view of Quan et al (U.S. Pat. No. 6,180,133 B1) ("Quan").

Rejection is maintained for the reasons of record as indicated in the previous Office action dated September 30, 2002.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11, and 13-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-7, 10-12, and 14-16 of copending Application No. 09/677,737. Although the conflicting claims are not identical, both claims are directed to skin care compositions comprising alpha hydroxy acids or salts thereof and overlapping ranges of akanolamines.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are not persuasive.

Applicants argue that Yu fails to teach or suggest the claimed method. Examiner notes that claimed method involves topically using the same composition via the same method steps as taught in Yu. Examiner reiterates that the Yu reference renders the instant claims obvious because the topical application of the composition comprising the recited components as taught by the prior art would necessarily produce the claimed function.

In response to applicants' argument that Yu and Znaiden are not combinable, examiner notes that both inventions are directed to skin care compositions. Applicants' assertion that the Znaiden patent is limited to treating cellulite is unpersuasive because the reference in fact teaches that the invention is used for improving skin strength and firmness. See Znaiden, abstract. Examiner asserts that the Yu and Znaiden provide motivation to combine the references since both patents are directed to skin treatment compositions comprising the same alpha-hydroxy acids.

Applicants' argue that the combined teaching of Yu, Znaiden, and Perricone fail to teach a mixture of anionic counterions derived from at least two pharmaceutically acceptable acids and esters thereof. Examiner respectfully disagrees. While Znaiden teaches using the salts of alpha-hydroxy acids to skin strength and firmness, Yu teaches using the ethanolamine salts of alpha-hydroxy acids to improve dry skin.

Topically using a composition comprising anions of alpha-hydroxy acids and ethanolamine to improve skin condition is already well known, as evidenced by the Yu reference, and rendered further obvious in view of Zaniden.

Applicants argue that the Quan and Yu references are not combinable, asserting that Quan, directed to an adhesive patch for anti-wrinkle treatment, does not teach or suggest the present invention. Examiner respectfully disagrees, as the Quan reference was cited to show that the type of the carrier which applicants claim in this case is well known in dermatological and cosmetic art.

Regarding the obviousness double patenting rejection, applicants assert that the claimed methods of the copending application 09/677,737 (method for ameliorating redness and inflammation of mammalian skin and method for ameliorating the irritating effects of skin irritating composition) fail to teach or suggest the claimed method of the instant application. Examiner respectfully disagrees. The two sets of the claims recite same method steps of topically applying same compositions. The methods of ameliorating redness, inflammation and skin irritation are necessarily practiced by the claimed method of the instant application.

Examiner also notes that it is not clear what "anionic counterions derived from . . . esters" are.

### ***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
April 21, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
4/21/03